

REMARKS

Claims 1-10 are pending in the application, and stand rejected. Claims 11-17 have been withdrawn.

Rejection under 35 U.S.C §103

Claims 1-2, 4-5, 8 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,721,781 to Deo in view of U.S. Pat. No. 5,794,054 to Le et al. In particular, the Examiner finds that, with regard to claims 1, 5 and 8, Deo discloses all of the claimed limitations except for measuring after the last restart of the transaction terminal. The Examiner further finds that “Le teaches the measuring by a trusted device associated with the transaction terminal after the last restart of the transaction terminal (Le, column 9 lines 1-48, microcontroller as trusted device that measures integrity of the bios following a reset).” The Examiner concludes that it would have been obvious to the skilled person “to utilize Le’s method of measuring integrity with Deo’s authentication system because it offers the advantage ... of providing reduced system cost, greater system reliability (Le, column 3 lines 40-45), and assurances that the bios is usable and non-corrupted (Le, column 1 lines 50-57).” Applicants respectfully disagree.

Applicants have previously explained that Deo does not in fact teach the acquiring of an integrity metric as claimed. In the previous Action, the Examiner replied that given its broadest reasonable interpretation, the terminal certificate of Deo can be viewed as an integrity metric. In their reply, Applicants explained that this interpretation is incorrect and, to make even clearer that an integrity metric is not akin to the terminal certificate of Deo, amended claims 1, 5 and 8 to specify that the integrity metric is measured by a trusted device associated with the transaction terminal after the last restart of the transaction terminal. In the present Action, the Examiner seizes upon this clarifying amendment – completely ignoring the previous discussion that Deo simply does not teach acquiring an integrity metric – and claims to find it in Le, conveniently slaps the two references together, and proclaims the result to be akin to the presently claimed invention. Nothing could be further from the truth.

In Deo the various terminals, smartcards, etc. exchange certificates that are not measured by a trusted device associated with the terminal but rather assigned by a separate, independent, non-related, third-party certifying authority. These certificates do nothing insofar as assessing the integrity of their respective device – all they do is authenticate the device as being the device it purports to be; this is true even if the integrity of device is in fact compromised, as the authentication certificates have no connection to the integrity of the device. Thus, even if the skilled person made the highly illogical choice of applying Le to Deo, the result would be completely nonsensical because the certificates of Deo are permanent and non-changing, and acquiring the certificate of a device of Deo every time the device is restarted (or, for that matter, eighty times a second) would only elicit the same certificate every time, regardless of whether the integrity of the device has been compromised or not.

Of course, by the Examiner's own admission the skilled person would not make such an illogical choice because as the Examiner correctly notes, Le teaches a device "that measures integrity of the bios following a reset." Thus, applying Le to Deo would produce a device that checks the integrity of its own bios following a reset, and provides an independently-assigned certificate when prompted to by another device. There is nothing in Le about providing the results of the bios integrity check to another device, and thus no motivation for the skilled person to do so in Deo even if attempting to modify Deo with Le.

Furthermore, Applicants respectfully traverse the Examiner's proffered motivation for combining Le with Deo. Le teaches the sharing of ROM between two processors, wherein one of the processors measures a checksum of the ROM to establish whether the *data* in the ROM has been corrupted and needs to be replaced. Thus, "the advantage of providing reduced system cost, greater system reliability... and assurances that the bios is usable and non-corrupted" is only an advantage to an arrangement wherein two processors share ROM. There is absolutely not one iota of motivation for a skilled person attempting to practice Deo's method for separate devices to authenticate one another to look at a reference such as Le that is concerned with allowing two processors to use the same ROM. What does sharing ROM have to do with physically separate, self-contained smart devices being able to authenticate one another? Moreover, there is no teaching in Le of measuring integrity of a device, merely of assessing whether *data* has been *corrupted*.

Applicants respectfully remind the Examiner that “[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2142. As fully set forth above, there is in fact no motivation either on the face of the references themselves nor, logically, in the general knowledge of the skilled person to combine these two references in the manner asserted by the Examiner; even if the combination was attempted, there is certainly no expectation of success on the face of either reference (and the Examiner has made no attempt at even identifying such indication of expected success in either reference); and, finally, the references do not in fact teach and every limitation of the instant claims.

In view of all of the preceding, Applicants respectfully submit that claims 1, 5 and 8 are in fact patentable over the art on record, and respectfully request the Examiner to kindly reconsider and pass these claims to issue.

Claims 2 and 4 are dependent on claim 1, and claim 10 is dependent on claim 8. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of claims 1, 5 and 8, Applicants submit that claims 2, 4 and 10 are also allowable.

Claims 3 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Deo and Le in view of U.S. Pat. No. 6,694,436 to Audebert, claim 7 as unpatentable over Deo, Le, Audebert and further in view of U.S. Pat. No. 6,772,331 to Hind, and claim 9 as unpatentable over Deo and Le in view of U.S. Pat. No. 5,272,754 to Boerbert.

Claims 3, 6, and 7 and 9 depend from claims 1, 5 and 8, respectively. Therefore, in light of the above discussion of claims 1, 5 and 8, Applicants submit that claims 3, 6, 7 and 9 are also allowable.

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

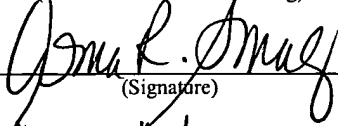
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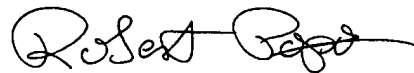


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Respectfully submitted,



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